



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Jimmy Tsen et al.
Serial No. : 09/994,439
Filed : November 26, 2001
Title : SHOE

Art Unit : 3728
Examiner : Marie D. Patterson

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
FEB 24 2004
TECHNOLOGY CENTER R3700

#14
Buy
E. J. J. J.
2/27/04

BRIEF ON APPEAL FROM FINAL OFFICE ACTION OF SEPTEMBER 16, 2003

(1) Real Party in Interest

The real party in interest is SRL, Inc.

(2) Related Appeals and Interferences

There are no pending related appeals or interferences.

(3) Status of Claims

Claims 1-6, 8-27, and 29-32 are pending, all of which have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,932,950 ("Taber") in view of U.S. Patent No. 5,572,805 ("Giese") and U.S. Patent No. 2,481,389 ("Campagna").

(4) Status of Amendments

An amendment is submitted herewith to correct inadvertent errors related to the dependencies of claims 8 and 29.

(5) Summary of Invention

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

February 17, 2004

Date of Deposit

Linda M. White

Signature

Linda M. White

Typed or Printed Name of Person Signing Certificate

In one aspect, recited in claim 1, the invention relates to a shoe having a molded rubber outsole and a molded midsole positioned within the outsole, where the midsole is contoured to approximate the shape of the sole of a wearer's foot. The shoe also includes an upper and a foxing. The foxing is fused to the upper and the outsole along an interface by application of a vulcanization process, thus permanently securing together the upper and the outsole. Some advantages of Applicants' invention are that the shoe can be easily constructed and can be shaped to fit the contours of the sole of the wearer's foot using an ergonomic, lasted upper and a lightweight, contoured midsole.

In another aspect, as recited in claim 19, the invention relates to a method of forming a shoe. The method includes positioning a molded midsole within an outsole where the midsole is contoured to approximate the shape of a sole of a wearer's foot. With the midsole in place in the outsole, an upper is placed over the midsole to form a seam between the upper and the outsole. A foxing material is placed around the shoe over the same to contact the upper and the outsole across the seam, and the shoe is vulcanized to fuse the foxing material to the upper and the outsole.

In other aspects, as recited in claims 27 and 30, the invention features a shoe having, inter alia, a molded rubber outsole defining an open area surrounded by a rim, the outsole being formed of a first material having a first density, and a molded midsole disposed within the open area of the outsole, the midsole being formed of a second material having a relatively lower density than the first material. Like the shoes discussed above, these shoes include a foxing that is fused to the upper and the outsole by a vulcanization process.

(6) Issues

Are claims 1-6, 8-27, and 29-32 obvious under 35 U.S.C. § 103 over Taber in view of Giese and Campagna?

(7) Grouping of Claims

Claims 1-6, 8-27, and 29-32 stand or fall together.

(8) Argument

35 U.S.C. 103:

All of the claims are rejected under 35 U.S.C. § 103(a) as being unpatentable over Taber in view of Giese and Campagna. The Examiner cites portions of the Taber disclosure to provide a teaching of a molded rubber outsole, a molded midsole, an upper, a base panel, an insole, and foxing. Giese is then cited to provide teachings such as providing an outsole in the shape of a shell having a rim, placing the midsole within the shell, and contouring the midsole. Finally, Campagna is cited for a teaching of curing uncured rubber to provide a foxing.

After citing the teachings of the various references, the Examiner makes the conclusory assertion that it would have been obvious to modify the Taber shoe by (a) providing a contoured midsole and shell shaped outsole as taught by Giese, and then (b) forming a seam between the outsole and upper, and finally (c) vulcanizing a foxing thereon, as taught by Campagna. The Examiner contends that the artisan would have made this series of modifications "to increase comfort, support, stability, durability, etc."

Nothing in the prior art of record would have led the artisan to pick and choose the features from the references and combine them as suggested by the Examiner. Rather, Applicants assert that the Examiner's conclusory statement is a result of an improper reliance upon hindsight, using Applicants' claimed invention as an instruction manual to piece together the teachings of the prior art to render the claimed invention obvious. (See e.g., *In re Fritch* 972 F.2d 1260, 1266 (1992).)

Taber teaches a number of different shoe constructions as shown in Figures 5 through 8. The only embodiment that discloses a foxing is found in Figure 7. The Examiner arbitrarily selects Figure 7, with Applicant's disclosure before her, as a starting point for her proposed reconstruction. Nothing in Taber, or the other art of record, teaches or suggests that the shoe construction of Figure 7 would serve "to increase comfort, support, stability, durability, etc." more than the other shoe constructions disclosed in Figures 5, 6, or 8. Nor does the Examiner explain why the shoe construction of Figure 7 would be more amenable to combination with a molded midsole than the other shoe constructions described by Taber. Moreover, the Examiner fails to identify any motivation for a skilled artisan art to select the shoe construction of Figure 7 of Taber for modification over other shoe constructions, as the Examiner proposes.

The Examiner combines the shoe construction described in Figure 7 of Taber with the sole described in Figures 78-82 in Giese, selected by the Examiner from the approximately 150 figures describing shoe sole constructions. Nothing in Giese teaches the use of such a composite in a shoe construction as disclosed in Figure 7 of Taber. Nor does the Examiner identify motivation for one of skill in the art to choose to combine the shoe composite described in Figures 78-82 of Giese with the shoe construction disclosed in Figure 7 (e.g., rather than the shoe constructions disclosed in Figures 5, 6, or 8) of Taber. Moreover, while Giese provides five figures demonstrating various shoe constructions (See Figures 153-157), none of these figures includes a shoe constructed as depicted in Figure 7 of Taber, nor does any of the shoe constructions depicted in Giese use a foxing as featured in the Applicants' invention.

Campagna is cited for its teaching of a use of uncured rubber for a foxing and subsequently vulcanizing the foxing to the sole of a shoe. Nothing in Campagna teaches or fairly suggests the use of the described means of attachment with the shoes as described by Taber or Giese, much less with the hypothetical shoe construction that would result from the Examiner's proposed combination of Taber and Giese.

Nothing in the references themselves suggests that the combination proposed by the Examiner would serve to "increase comfort, support, stability, durability, etc." as suggested by the Examiner. Moreover, nothing in Taber or the other cited references suggests that such qualities are lacking in the Taber shoe, or that the Taber shoe would be improved in any way by modifying it as proposed.

Applicants acknowledge that there is no requirement for express articulation in the references themselves of the motivation for making a particular modification or combination. However, more is required of an Examiner in identifying motivation for combining and/or modifying the references to achieve Applicants' invention than a mere assertion that "all of the references are directed towards shoes and methods of making/forming the shoes which have foxings and molded elements." (See Final Office Action, page 4, second full paragraph.)

Rather, obviousness can only be established by combining or modifying the teaching of the prior art where there is some teaching, suggestion, or motivation for doing so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. (See M.P.E.P. §2143.01) Motivation cannot come from the

Applicant : Jimmy Tsen et al.
Serial No. : 09/994,439
Filed : November 26, 2001
Page : 5 of 9

Attorney's Docket No.: 06128-266001

invention itself. (See, e.g., Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 1072 (Fed. Cir. 1993). Furthermore, *prima facie* obviousness cannot be established by "using hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

The Applicants themselves discovered that the claimed combination of features provides a securely constructed, lightweight shoe that is easily constructed and is shaped to fit the contours of the sole of the wearer's foot. (See Applicants' disclosure, p. 2, lines 8-10.) The Examiner has failed to identify any motivation for combining the references in the manner proposed, and the rejection for obviousness is therefore improper. Accordingly, Applicants request that this rejection be withdrawn.

The brief fee of \$330 is enclosed. Please apply any other charges or credits to Deposit Account No. 06-10501, referencing attorney docket number 06128-266001.

Respectfully submitted,

Date: February 17, 2004

Catherine M. McCarty
Catherine M. McCarty
Reg. No. 54,301

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

Appendix of Claims

1. A shoe comprising
a molded rubber outsole;
a molded midsole disposed within said outsole, said midsole being contoured to approximate the shape of the sole of a wearer's foot;
an upper; and
a foxing, said foxing being fused to said upper and said outsole along an interface there between by application of a vulcanization process permanently securing together said upper and said outsole.
2. The shoe of claim 1, wherein said upper and said outsole define a seam extending around said shoe at said interface, and said foxing is disposed around said shoe over said seam to contact said upper and said outsole across said interface.
3. The shoe of claim 1, wherein said outsole comprises a cored out shell defining a space for receiving said midsole.
4. The shoe of claim 1, wherein said upper comprises a base panel disposed adjacent said midsole and encasing said midsole within said outsole.
5. The shoe of claim 1 or claim 4, wherein said upper comprises a base panel comprising a material that adopts the shape of a contoured midsole when formed around a contoured last.
6. The shoe of claim 1, wherein said midsole comprises a material relatively less dense than cured rubber.
8. The shoe of claim 1 or claim 7, wherein said midsole comprises polyvinyl urethane.
9. The shoe of claim 1, wherein said upper comprises a base panel comprising a cradle cup heel.

10. The shoe of claim 1 or claim 9, wherein said upper comprises a base panel comprising a molded arch.
11. The shoe of claim 1, wherein said midsole comprises a cradle cup heel.
12. The shoe of claim 1, wherein said midsole comprises a molded arch.
13. The shoe of claim 1, wherein said upper comprises a sheet material selected from the group consisting of canvas and polyvinyl urethane.
14. The shoe of claim 1, wherein components of said upper are secured by stroebel stitching.
15. The shoe of claim 1, wherein said foxing material comprises uncured rubber prior to the vulcanization process.
16. The shoe of claim 1 or claim 15, wherein said foxing is in the form of a band.
17. The shoe of claim 4, further comprising an insole disposed over said base panel within said upper.
18. The shoe of claim 17, wherein said insole is removable from said shoe.
19. A method of forming a shoe, said method comprising the steps of:
positioning a molded midsole within an outsole, the midsole being contoured to approximate the shape of a sole of a wearer's foot;
with the midsole in place in the outsole, placing an upper over the midsole to form a seam between the upper and the outsole;

placing a foxing material around the shoe over the seam to contact the upper and the outsole across the seam; and

vulcanizing the shoe to fuse the foxing material to the upper and the outsole.

20. The method of claim 19, wherein components of the upper are secured by stroebel stitching.

21. The method of claim 19, wherein the upper is formed by stretching about a last.

22. The method of claim 21, wherein the last is removed from the upper after the shoe is vulcanized.

23. The method of claim 21, wherein the last is contoured.

24. The method of claim 23, wherein the last includes a contoured bottom approximating the contours of the sole of a human foot.

25. The method of claim 19, comprising the further step of inserting a removable insole into the shoe after vulcanizing.

26. The method of claim 19, comprising the further step of molding the midsole to include a cradle heel cup and a molded arch.

27. A shoe comprising:

a molded rubber outsole defining an open area surrounded by a rim, the outsole being formed of a first material having a first density;

a molded midsole disposed within the open area of said outsole, said midsole being formed of a second material having relatively lower density than said first material;

an upper; and

a foxing, said foxing being fused to said upper and said outsole along an interface there between by application of a vulcanization process permanently securing together said upper and said outsole.

29. The shoe of claim 27 or claim 28, wherein said second material comprises polyvinyl urethane.

30. A shoe comprising:

a molded rubber outsole defining an open volume surrounded by a rim, said outsole being formed of a first material having a first density;

a molded midsole disposed within said open volume of said outsole, said midsole being formed of a second material having relatively lower density than said first material and being contoured to approximate the shape of the sole of a wearer's foot;

an upper having a base panel contoured to approximate the shape of the sole of the wearer's foot; and

a foxing material, the foxing material being fused to the upper and the outsole upon application of a vulcanization process to permanently secure the upper to the outsole.

31. The shoe of claim 30, further comprising a removable insole.

32. The shoe of claim 30 or claim 31, wherein said midsole comprises a cradle cup heel and a molded arch.